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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,905	04/06/2001	Mikio Iwase	088941/0193	6507

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EXAMINER

AKERS, GEOFFREY R

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

SW

# Office Action Summary

Application No.

09/826905

Applicant(s)

Enose

Examiner

Sherr, g

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12/16/03
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Response to Amendment***

1. This action is issued in response to applicant's Amendment A(Paper #6) filed 12/16/03.
2. Claims 1-7 and 9-15 were amended. No claims were added. None were deleted.
3. Claims 1-16, as amended, are pending.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-16 are rejected under 35 USC 103(a) as unpatentable over Embrey(US Pat. No: 6,311,170) in view of Martin(US Pat. No: 6,304,860).
6. As per claims 1-16 Embrey teaches an apparatus for making payments and delivering payment information(Abstract)(Figs 1-34)(col 2 line 50-col 6 line 20) including a service provider(Fig 1/11) and a clearinghouse(Fig 1/55) including a trusted intermediary financial institution(Fig 1/13) and subscriber banks(Fig 1/35) and payee banks(Fig 1/37) as well as payees(Fig 1/17) and subscribers(Fig 1/15).Embrey also teaches a LAN(Fig 2) configuration. Embrey further teaches a trusted intermediary financial institution(Fig 4/13) and utilization of positive pay in making the payments(Fig 4/12) as well as check details(Figs 11-13) including number, amount, payee

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identification, payor identification, payment obligation (Fig 24/975). Embrey also teaches authorizing electronic funds (Fig 30/1425) and pay information for the negotiable instrument (Fig 30/1413) and performing the EFT operation (Fig 30/1431) as well as a complete record of payment (Fig 31/1517) and communicating payment information (Fig 33/1623). In addition to that taught by Embrey, Martin teaches inputting the information into a network terminal (Abstract) (Figs 2-7) (col 4 line 15-col 8 line 32) which can be an ATM (Fig 2) including a transaction processor (Fig 2/14) and an electronic debit (Fig 2/25) and transaction information and confirmation records (Fig 2/21). Martin further teaches logging into the network access device including entering a PIN (Fig 3/302) with the transaction processor returning an authorization message (Fig 3/312) as well as daily downloads of transaction data from ATM network processor (Fig 6/600) and updating loans, accounts, balances and payment records (Fig 7). Martin further teaches a clearing operation (Fig 2/20) and a confirmation record (Fig 2/32) as well as settlement verification (Fig 2/35). It would have been obvious to one skilled in the art at the time of the invention to combine Embrey in view of Martin to teach applicant's disclosure. The motivation to combine is to teach a method for making debt payments between two entities through entry at a terminal and through a clearing house debit and crediting operation as enunciated by Martin (col 4 lines 16-32).

### ***Response to Arguments***

7. Applicant's arguments have been considered but are not persuasive. Martin teaches direct transfer from buyer (borrower) bank to seller (lender) bank (Fig 3/302/304/306/316/318/320). Martin teaches identifying the loan (seller) (Fig 3/304). Martin teaches direct

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payment from the debtor's bank to the creditor's bank(Fig 3/316) following clearing.


Martin teaches only a payment facilitator but not a trusted third party(Fig 4/402).

***Conclusion***

8. THIS ACTION IS MADE FINAL.

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9. Any questions concerning this communication should be addressed to the primary examiner of record, Dr. Geoffrey Akers, P.E., who can be reached between 6:30 AM and 5:00 PM Monday through Friday at 703-306-5844. If attempts to contact the primary examiner are unsuccessful, the primary examiner's superior, Mr. Vincent Millin, SPE, may be telephoned at (703)-308-1065.

  
March 2, 2004

DR. GEOFFREY R. AKERS, P.E.  
PRIMARY EXAMINER